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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,720	01/26/2004	Gilad Odinak	INTL-1-1039	2555
25315 7590 01/07/2010 BLACK LOWE & GRAHAM, PLLC 701 FIFTH AVENUE SUITE 4800 SEATTLE, WA 98104				
EXAMINER ZEWARI, SAYED T				
ART UNIT		PAPER NUMBER		
2617				
NOTIFICATION DATE		DELIVERY MODE		
01/07/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing-patent@blacklaw.com  
blgdocketing@blacklaw.com

### Office Action Summary

**Application No.**

10/765,720

**Applicant(s)**

ODINAK, GILAD

**Examiner**

SAYED T. ZEWARDI

**Art Unit**

2617

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Argument***

1. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

2. Claims 5-6 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions<sup>2</sup> indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example the claims 5 and 6 read a computer program product residing on a phone. It should read as computer residing on a computer readable medium.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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<sup>1</sup> *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

<sup>2</sup> *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson et al. (US 6,697, 638) in view of Khullar (6748246).

With respect to claim 1, Larsson et al. discloses a computer program product residing on a phone embedded in a vehicle for performing a method for automatically using a service plan of a personal mobile phone over the phone embedded within the vehicle (**See Larsson's col.5 lines 9-29**), the method comprising: detecting the presence of the personal mobile phone (**See Larsson's abstract, figure 3, 4, col.3 lines 24-67, col.4 lines 1-20**); receiving a mobile subscriber identification number from the detected phone (**See Larsson's abstract, col.5 lines 58-67, col.6 lines 1-15, col.7 lines 10-11, lines 18-25**); sending the mobile subscriber identification number to a wireless network authority; transmitting the mobile subscriber identification number from the embedded phone to a wireless network access authority (**See Larsson's abstract, col.5 lines 58-67, col.6 lines 1-15, col.7 lines 10-11, lines 18-25, col.7 lines 10-11**); sending an authentication request received from the network authority to the personal mobile phone (**See Larsson's abstract, figure 3-5, col.3 lines 24-67, col.4 lines 1-20**); receiving a confirmation of the authentication from the personal mobile phone (**See Larsson's col.5 lines 9-29**); sending the confirmation of the authentication to the wireless network authority (**See Larsson's abstract, col.5 lines 58-67, col.6 lines 1-**

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**15, col.7 lines 10-11, lines 18-25, col.7 lines 10-11**); and after ending the communication, opening a communication session with the wireless network based on the sent confirmation (**See Larsson's abstract, col.5 lines 58-67, col.6 lines 1-15, col.7 lines 10-11, lines 18-25, col.7 lines 10-11 figure 5, figure 3-5, col.3 lines 24-67, col.4 lines 1-20**). Larsson discloses everything claimed as applied above to claim 5, except for explicitly reciting ending communication between the mobile and embedded phone. In analogous art, Khullar discloses a communication system wherein one of two transceivers are disabled for power considerations when another transceiver is in communication (**See Khullar's figure 3, col.5 lines 66-67, col.6 lines 1-31**). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Larsson by specifically using the method used in Khullar, for saving battery power, to deactivate one transceiver when another transceiver is active, as disclosed by Khullar.

With respect to claim 6, Larsson discloses a computer program product residing in a phone embedded within a vehicle, the computer program product comprising: a first component for detecting the presence of a personal mobile phone (**See Larsson's abstract, figure 3, 4, col.3 lines 24-67, col.4 lines 1-20**); a second component for receiving a mobile subscriber identification number from the detected phone (**See Larsson's abstract, col.5 lines 58-67, col.6 lines 1-15, col.7 lines 10-11, lines 18-25**), a third component for sending the mobile subscriber identification number to a wireless network authority (**See Larsson's abstract, col.5 lines 58-67, col.6 lines 1-15, col.7 lines 10-11, lines 18-25, col.7 lines 10-11**); a fourth component for sending

an authentication request received from the network authority to the personal mobile phone (**See Larsson's abstract, col.5 lines 58-67, col.6 lines 1-15, col.7 lines 10-11, lines 18-25, col.7 lines 10-11**); a fifth component for receiving a confirmation of the authentication request from the personal mobile phone (**See Larsson's abstract, col.5 lines 58-67, col.6 lines 1-15, col.7 lines 10-11, lines 18-25, col.7 lines 10-11**); a sixth component for sending the confirmation of the authentication request to the wireless network authority (**See Larsson's abstract, col.5 lines 58-67, col.6 lines 1-15, col.7 lines 10-11, lines 18-25, col.7 lines 10-11**); and an eighth component for opening, after ending the communication, a communication session with the wireless network based on the sent confirmation (**See Larsson's abstract, col.5 lines 58-67, col.6 lines 1-15, col.7 lines 10-11, lines 18-25, col.7 lines 10-11 figure 5, figure 3-5, col.3 lines 24-67, col.4 lines 1-20**). Larsson discloses everything claimed as applied above to claim 6, except for explicitly reciting ending communication between the mobile and embedded phone. In analogous art, Khullar discloses a communication system wherein one of two transceivers are disabled for power considerations when another transceiver is in communication (**See Khullar's figure 3, col.5 lines 66-67, col.6 lines 1-31**). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Larsson by specifically using the method used in Khullar, for saving battery power, to deactivate one transceiver when another transceiver is active, as disclosed by Khullar.

With respect to claim 7, Larsson discloses a vehicle comprising: an embedded phone operable to: detect the presence of the personal mobile phone (**See Larsson's**

**abstract, figure 3, 4, col.3 lines 24-67, col.4 lines 1-20);** receive a mobile subscriber identification number from the detected phone **(See Larsson's abstract, col.5 lines 58-67, col.6 lines 1-15, col.7 lines 10-11, lines 18-25),** send the mobile subscriber identification number to a wireless network authority **(See Larsson's abstract, col.5 lines 58-67, col.6 lines 1-15, col.7 lines 10-11, lines 18-25, col.7 lines 10-11);** send an authentication request to the personal mobile phone **(See Larsson's abstract, figure 3-5, col.3 lines 24-67, col.4 lines 1-20);** receive a confirmation of the authentication **(See Larsson's col.5 lines 9-29);** send the confirmation of the authentication to the wireless network authority **(See Larsson's abstract, col.5 lines 58-67, col.6 lines 1-15, col.7 lines 10-11, lines 18-25, col.7 lines 10-11);** and after ending the communication, open a communication session with the wireless network based on the sent confirmation **(See Larsson's abstract, col.5 lines 58-67, col.6 lines 1-15, col.7 lines 10-11, lines 18-25, col.7 lines 10-11 figure 5, figure 3-5, col.3 lines 24-67, col.4 lines 1-20).** Larsson discloses everything claimed as applied above to claim 7, except for explicitly reciting ending communication between the mobile and embedded phone. In analogous art, Khullar discloses a communication system wherein one of two transceivers are disabled for power considerations when another transceiver is in communication **(See Khullar's figure 3, col.5 lines 66-67, col.6 lines 1-31).** It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Larsson by specifically using the method used in Khullar, for saving battery power, to deactivate one transceiver when another transceiver is active, as disclosed by Khullar.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAYED T. ZEWARDI whose telephone number is (571)272-6851. The examiner can normally be reached on 8:30-4:30.
6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sayed T Zewari/

Examiner, Art Unit 2617

/LESTER KINCAID/

Supervisory Patent Examiner, Art Unit 2617